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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO.       |
|--|-------------|----------------------|----------------------------|------------------------|
| 10/667,741   | 09/22/2003  | Bill H. Hilf         | BOC9-2003-0020 (389)       | 1884                   |
| 40987  | 7590        | 10/05/2007           |                            |                        |
| AKERMAN SENTERFITT<br>P. O. BOX 3188<br>WEST PALM BEACH, FL 33402-3188 |             |                      | EXAMINER<br>ANWARI, MACEEH |                        |
|  |             |                      | ART UNIT<br>2144           | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>10/05/2007    | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/667,741

Applicant(s)

HILF ET AL.

Examiner

Maceeh Anwari

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/21/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This is the initial Office action based on the 10/667,741 application filed on 9/22/2003. Claims 1-22, as originally filled, are currently pending and have been considered below.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant uses the term *affinity*, a term not so well known in the art, throughout the text of the instant claims; however the applicant fails to successfully delineate what it is. Therefore, the examiner will interpret this term to be any application available to users in a collaborative computing environment.

#### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-20 are rejected under 35 U.S.C. 101 because the claims fail to place the invention squarely within one statutory class of invention. On paragraph 14 of the instant specification, applicant has provided evidence that applicant intends the "medium" to include signals. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not

statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefore not a composition of matter.

Claims 21-22 are rejected under 35 U.S.C. 101 because the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "non-functional descriptive material." Both types of "descriptive material" are non-statutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because

"[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 & 6-12 & 16-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Besaw et al. (hereinafter Besaw) U.S. Patent No.: 6,308,212.

Besaw teaches:

**Claim 1:** A method for creating user groups in a network environment comprising the steps of: identifying at least one affinity among a plurality of user sessions (Figures 1-3 and Abstract & Col. 1 lines 52-65; session manager); and responsive to said affinity identification, prompting a plurality of users to engage in communication (Figures 2 and Abstract & Col. 1 line 66- Col. 2 line 10 & Col. 7 lines 2-11; login requirement).

**Claim 2:** Further comprising the step of monitoring said plurality of user sessions (Figures 1-3 and Abstract & Col. 4 lines 37-46; session manager and session initialization).

**Claim 6:** Wherein said identifying step includes the step of evaluating session cookies associated with said user sessions (Figures 1-3 and Col. 1 lines 23-33 & Col. 2 lines 20-31; CGI and cookie monitoring).

**Claim 7:** Wherein said identifying step includes the step of evaluating session objects associated with said user sessions (Figures 1-3 and Col. 2 lines 11-31 & Col. 3 line 62- 66; session manager, session properties and Web UI).

**Claim 8:** Wherein said session objects comprise at least one datum selected from the group consisting of a URL which has been accessed, an amount of time on-line, an item in a shopping cart, and a user identifier (Figures 1-3 and Col. 2 lines 52-61; timeout period, session manager, login CGI and login log file).

**Claim 9:** Wherein said user identifier comprises at least one of a postal code, an area code, a city, a county, a state, a province, a country and a continent (Figures 1-7 and Col. 2 lines 21-31; session manager, session number and remote IP address).

**Claim 10:** A method for creating user groups in a network environment comprising the steps of: identifying at least one affinity among a plurality of user sessions (Figures 1-3 and Abstract & Col. 1 lines 52-65; session manager); and responsive to said affinity identification, presenting a user interface to at least one user (Figures 1-3 and Col. 2 lines 11-31 & Col. 3 line 62- 66; session manager, session properties and Web UI).

**Claims 11-20** list all the same elements of **claims 1-10**, but in machine-readable storage form rather than method form. Therefore, the supporting rationale of the rejection to **claims 1-10** applies equally as well to **claim 11-20**.

**Claim 21** is substantially the same as **claim 1** and is thus rejected for reasons similar to those in rejecting **claim 1**.

**Claim 22** is substantially the same as **claim 10** and is thus rejected for reasons similar to those in rejecting **claim 10**.

**Examiner Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claim 3 rejected under 35 U.S.C. 103(a) as being obvious over Besaw et al. (hereinafter Besaw), U.S. Patent No.: 6,308,212 and further in view of Berkowitz et al (hereinafter Berkowitz) U.S. Patent No.: 5,392,400.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Besaw teaches the invention as disclosed above.

Besaw also teaches java applets and other web applications (Figures 1-4 and Abstract & Col. 1 lines 52-65 & Col. 2 lines 63-67 & Col. 4 lines 37-46; APIs, CGI, Java applets and web applications).



Besaw does not appear to explicitly disclose wherein said initiating step further comprises the step of providing access to an interaction application for said at least two of said plurality of user sessions responsive to said identified affinity.

However, Berkowitz discloses Wherein said initiating step further comprises the step of providing access to an interaction application for said at least two of said plurality of user sessions responsive to said identified affinity (Figures 2-4A; common control window and display to all participants, participants can view and input data to application window).

Besaw and Berkowitz are analogous art because they are from the same field of endeavor of collaborative computing.

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Besaw and Berkowitz before him or her, to incorporate a network environment prompting a plurality of users to engage in communication, as disclosed by Besaw, with providing an interaction application for said at least two of said plurality of user sessions responsive to said identified affinity, as disclosed by Berkowitz.

The motivation for doing so would have been to allow users a more interactive network environment to engage in communication.

Therefore, it would have been obvious to combine Besaw with Berkowitz to obtain the invention as specified in the instant claim.

6. Claim 4 rejected under 35 U.S.C. 103(a) as being obvious over Besaw et al. (hereinafter Besaw), U.S. Patent No.: 6,308,212 and further in view of Berkowitz et al (hereinafter Berkowitz) U.S. Patent No.: 5,392,400.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Besaw teaches the invention as disclosed above.

Besaw also teaches java applets and other web applications (Figures 1-4 and Abstract & Col. 1 lines 52-65 & Col. 2 lines 63-67 & Col. 4 lines 37-46; APIs, CGI, Java applets and web applications).

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Besaw does not appear to explicitly disclose wherein said prompting step further comprises the step of establishing a communication pathway to facilitate real time communications between users associated with said at least two user sessions.

However, Berkowitz discloses wherein said prompting step further comprises the step of establishing a communication pathway to facilitate real time communications between users associated with said at least two user sessions (Figures 2-4A; common control window and display to all participants, participants can view and input data to application window).

Besaw and Berkowitz are analogous art because they are from the same field of endeavor of collaborative computing.

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Besaw and Berkowitz before him or her, to incorporate a network environment prompting a plurality of users to engage in communication, as disclosed by Besaw, with said prompting step further comprising of establishing a communication pathway to facilitate real time communications between users associated with said at least two user sessions, as disclosed by Berkowitz.

The motivation for doing so would have been to allow users a more interactive network environment to engage in communication.

Therefore, it would have been obvious to combine Besaw with Berkowitz to obtain the invention as specified in the instant claim.

7. Claim 5 rejected under 35 U.S.C. 103(a) as being obvious over Besaw et al. (hereinafter Besaw), U.S. Patent No.: 6,308,212 and further in view of Berkowitz et al (hereinafter Berkowitz) U.S. Patent No.: 5,392,400.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Besaw teaches the invention as disclosed above.

Besaw also teaches java applets and other web applications (Figures 1-4 and Abstract & Col. 1 lines 52-65 & Col. 2 lines 63-67 & Col. 4 lines 37-46; APIs, CGI, Java applets and web applications).

Besaw does not appear to explicitly disclose wherein said step of establishing a communication pathway further comprises the step of opening at least one of a chat session, an instant messaging session, a newsgroup, and a shared application.

However, Berkowitz discloses wherein said step of establishing a communication pathway further comprises the step of opening at least one of a chat session, an instant messaging session, a newsgroup, and a shared application (Figures 1-10B; common control window and display to all participants, participants can view and input data to application window, message queue, *viewshare* and *controlshare*).

Besaw and Berkowitz are analogous art because they are from the same field of endeavor of collaborative computing.

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Besaw and Berkowitz before him or her, to incorporate a network environment prompting a plurality of users to engage in communication, as disclosed by Besaw, with said step of establishing a communication pathway further comprises the step of opening at least one of a chat session, an instant messaging session, a newsgroup, and a shared application, as disclosed by Berkowitz.

The motivation for doing so would have been to allow users a more interactive network environment to engage in communication.

Therefore, it would have been obvious to combine Besaw with Berkowitz to obtain the invention as specified in the instant claim.

**Claims 13-15** list all the same elements of **claims 3-5**, but in machine-readable storage form rather than method form. Therefore, the supporting rationale of the rejection to **claims 3-5** applies equally as well to **claim 13-15**.

**Examiner Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maceeh Anwari whose telephone number is 571-272-7591. The examiner can normally be reached on Monday-Friday 7:30-5:00 PM ES.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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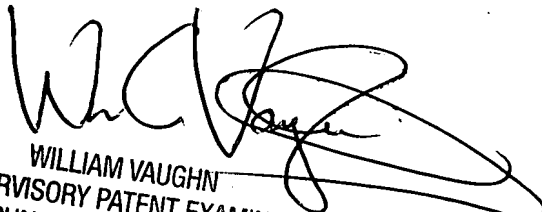
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M.A.

  
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